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PATENT
P56942

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

PARK, IL-DONG

Serial No.: 10/669,747 ✓ Examiner: MAI, TRI M.

Filed: 25 September 2003 Art Unit: 3727

For: A PACKING CRATE

PETITION UNDER 37 CFR §1.144

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant respectfully petitions from a finality of a restriction requirement of Paper No. 20050524 mailed May 31, 2005 and finalized on Paper No. 20050904 mailed September 9, 2005.

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Date: 11/1/05
I.D.: REB/ML/fw

STATEMENT OF FACTS

1. On 17 November 2004, a first Office action (Paper No. 20041112) was mailed where all 18 claims were examined on the merits;
2. On 14 March 2005, Applicant filed an amendment in response to Paper No. 20041112;
3. On 31 May 2005, a Restriction Requirement was mailed (Paper No. 20050524) restricting apparatus claims 1-6 and 11-18 from method claims 7-10;
4. On 9 June 2005, Applicant filed a response under 37 C.F.R. 1.143 provisionally electing the apparatus claims while traversing the restriction requirement; and
5. On 9 September 2005, another non-final Office action was mailed (Paper No. 20050904) examining only claims drawn to the elected group. In Paper No. 20050904, the Examiner acknowledged Applicant's 9 June 2005 37 C.F.R. 1.143 traversal but finalized the 31 May 2005 Restriction Requirement.

REMARKS

The following restriction requirement was imposed in Paper No. 20050524 and finalized in Paper No. 20050904:

- I. Claims 1-6 and 11-18 drawn to a container, classified in class 229, subclass 198; and
- II. Claims 7-10 drawn to a method of making a crate, classified in class 493, subclass 84.

The Examiner reasoned in Paper No. 20050524 that these two groups are distinct because the product can be made by another process, such as the sewing can be done by hand instead of by machine, and that the sewing can be done before the application of the adhesive instead of afterwards.

1. Present Restriction Requirement was not imposed in a first action or at the first opportunity

MPEP 811 states that an imposition of a restriction requirement should be done in the first action. In the present case, the restriction requirement was done after the first action on the merits, after Paper No. 20041112. This is important as the Applicant is a small entity, of limited resources, and is greatly prejudiced by fickleness of the Examiner constantly changing his mind time after time again in the prosecution of this patent application. Applicant believes that he should not be disadvantaged by the Examiner's continual self-reversals. Further, Applicant submits that the notion

of compact prosecution must be honored. For these reasons, the restriction requirement of Paper No. 20050524 must be withdrawn since it was not timely given.

2. A single embodiment must never be restricted

MPEP 806.03 mandates that a patent application must never be restricted when only a single embodiment is disclosed and claimed. In the present application, only one embodiment is disclosed and claimed. Therefore, Applicant submits that the restriction requirement of Paper No. 20050524 violates MPEP 806.03 and therefore must be withdrawn.

3. Examiner's justification for the restriction requirement is entirely without merit

In Paper No. 20050524, the Examiner justified the restriction requirement by saying that “the product can be made by another process, such as sewing can be done by hand, and the sewing can be done before the application of the adhesive”. Applicant disagrees.

To begin with, the sewing by machine feature and the sewing after application feature are not, and never were part of independent claim 7. These features were relegated to depending claims. Because they were not part of independent claim 7, Applicant submits that the Examiner's rationale for restriction can not and should not be used to restrict independent claim 7 from the Group I claims.

Next, Applicant disagrees regarding the Examiner's assertion that the sewing can

alternatively be done before the application of the adhesive. To do so would be impractical and nearly impossible, as it would be difficult or impossible to get the adhesive in between the folded over strip of the first stack and the second stack after the strip from the first stack and the second stack have been sewn together. Applicant asks the Examiner to turn to FIG. 1 of Applicant's figures. Applicant submits that if strip 66 of side portion 60 is first sewn to front portion 70, it would be difficult to later insert adhesive between strip 66 and front 70. For this reason, Applicant traverses the Examiner's assertion that Applicant's packing crate can be made of a materially different process.

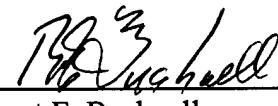
In justifying the restriction requirement, the Examiner also stated that the crate can be hand sewn instead of being machine sewn. The machine sewn limitation, which was previously part of depending claim 10, has already been canceled. Since this limitation has already been canceled from the claims, this materially different process cited by the Examiner is no longer valid.

RELIEF REQUESTED

Accordingly, the Commissioner is respectfully requested to:

- A. Insist that the restriction requirement of Paper No. 20050524 be withdrawn;
- B. Examine all of Applicant's claims on the merits without further undue process; and
- C. Grant such other and further relief as justice may require.

Respectfully submitted,



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